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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,836	02/11/2004	Joseph El-Hindi	131P008	3016
28264	7590	10/31/2007	EXAMINER	
BOND, SCHOENECK & KING, PLLC ONE LINCOLN CENTER SYRACUSE, NY 13202-1355			KIM, SUN U	
ART UNIT		PAPER NUMBER		
1797				
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10/31/2007		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/776,836	EL-HINDI, JOSEPH	
	<b>Examiner</b>	<b>Art Unit</b>	
	John Kim	1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 13 August 2007.
- 2a) This action is **FINAL**.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1,2 and 4-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,2 and 4-17 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 12 August 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

1. This Office Action is in response to the Amendment filed on 8/13/07.
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the air purge line interconnected to the inlet pipe must be shown or the feature(s) canceled from the claim, particularly claim 8. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the

invention. Recitation of “said chamber” on line 1 lacks a positive antecedent basis since claim 6 depends on a cancelled claim 3.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Wohrle (U.S. Patent No. 6,783,117 B2). Wohrle disclose a vessel comprising: a frame (202, 204, 206, 208) defining at least one compartment; a rack (214) for slidably engaged with the compartment and adapted for movement in a substantially horizontal plane into and out of the compartment (Fig. 2; col. 6, lines 15-55) and at least one candle housing (100) removeably positioned in the rack (214) wherein the candle housing (100) includes a mounting plate (110) and defines a chamber above the mounting plate (100) (Fig. 6; col. 5, line 7 – col. 6, line 13). Recitation of “for filtering oil” is an intended use of the apparatus. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

7. Claim 7 is rejected under 35 U.S.C. 102(b) as being anticipated by Anderson (U.S. Patent No. 2,843,267).

Regarding claim 7, Anderson discloses a filter vessel comprising: a frame (11, 17) defining at least one compartment having a female connector on a cover (17); an inlet pipe (32), a tubular rack (14, 45) having a male connector (48) and removeably positioned in the compartment such that the male connector (48) engages the female connector when the rack (45) is positioned within the compartment, at least one candle housing (29) including a plurality of filter elements (31) removeably positioned in the rack (14, 45) and in fluid communication with the rack (14, 45) and an outlet pipe (63) interconnected to the female connector (17) (Fig. 1-2, 4; col. 2, lines 53 – col. 4, line 2; col. 4, lines 27-60; col. 5, line 62 – col. 6, line 19); and at least one candle housing (29) having receptacles (30) removeably positioned in the rack (14) (see Fig 1).

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-2 and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson in view of Greig et al (US Patent No. 4,260,489) and Schmidt, Jr. et al (US Patent No. 3,438,502).

Regarding Claim 1, Anderson discloses a filter vessel comprising: a frame (11, 17) defining at least one compartment; a rack (14) having wheels (23) on rails (25) for slidingly engaged with the compartment and adapted for movement in a substantially horizontal plane into and out of the compartment (Fig. 1-2; col. 2, lines 53 – col. 3, line 45); and at least one candle housing (29) having receptacles (30) removeably positioned in the rack (14) (see Fig 1). Claim 1

essentially differs from the apparatus of Anderson in reciting the candle housing including a mounting plate and defines a chamber above the mounting plate. Greig et al teach that oily sludge is filtered by suitable surface filters including plate, leaf and tube or candle filters (see col. 2, lines 43-48). Schmidt, Jr. et al teach a tubular or candle filter comprising filter header (32) i.e. candle housing having a plurality of downwardly facing openings (34) having a hollow connector member (37) i.e. mounting plate having an internal pipe thread at the lower end thereof for sealably receiving filter elements (64) (see Figs. 1-3; col. 3, lines 70-75). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the candle housing (39) of Anderson with filter mounting plate for connecting tubular or candle filter elements to the housing as suggested by Schmidt, Jr. et al (see col. 3, lines 70-75; col. 4, lines 67-73).

Regarding claim 2, Anderson discloses a plurality of filter elements (31) suspended in the candle housing (29) (see Fig. 1; col. 3, lines 18-27).

Regarding claim 4, Schmidt, Jr. et al teach tubular filter element including a permeable core (66) that is threadably engaged to the mounting plate (37) via female coupling member (71) and in fluid communication with a chamber (32) above the mounting plate (37) (see Fig. 3; col. 4, lines 67-73).

Regarding claim 5, Anderson discloses that the rack (14) comprises candle housing (29) and header (45) being a hollow tube (Figs. 1-2; col. 3, lines 36-45; col. 4, lines 27-60).

Regarding claim 6, Schmidt, Jr. et al teaches that the chamber (32) is in fluid communication with the tubular rack (32) and filter elements (64) (see Fig. 3).

10. Claims 8-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson as applied to claim 7 above and further in view of Greig et al and Schmidt, Jr. et al. Anderson teaches the filter vessel as described in above paragraph 7.

Regarding claim 8, Anderson teaches an air purge line (36) interconnected to the inlet pipe (32) (see Fig. 1; col. 3, lines 36 – 58). Anderson further teaches that the housing (39) has a longitudinally spaced apart series of receptacles (30) in the top thereof to receive the nozzles of related filter leaves (31) (see col. 3, lines 18-27). However, Anderson does not teach a sludge purge line positioned in the bottom of the compartment and an overflow line positioned in the top of the compartment. Greig et al teach that oily sludge is filtered by suitable surface filters including plate, leaf and tube or candle filters (see col. 2, lines 43-48). Schmidt, Jr. et al teach the filter vessel comprising a purge line (18) in the bottom of the compartment for removal of solids and an overflow line (121) in the top of the compartment to remove air trapped in the compartment (see col. 5, line 69 – col. 6, line 55). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the apparatus of Anderson to incorporate a purge line and an overflow line positioned in the bottom and top of the compartments to remove solids and air respectively as suggested by Schmidt, Jr. et al (see col. 6, lines 25-55).

Regarding claim 9, Anderson teaches a door (17) and a handle (26) attached to the door (26) (see col. 2, line 67 – col. 3, line 17).

Regarding claim 10, Claim 10 essentially differs from the apparatus of Anderson in reciting the candle housing including a mounting plate for threadably engaging filter elements. Greig et al teach that oily sludge is filtered by suitable surface filters including plate, leaf and

tube or candle filters (see col. 2, lines 43-48). Schmidt, Jr. et al teach a tubular or candle filter comprising filter header (32) i.e. candle housing a plurality of downwardly facing openings (34) having a hollow connector member (37) i.e. mounting plate having an internal pipe thread at the lower end thereof for sealably receiving filter elements (64) (see Figs. 1-3; col. 3, lines 70-75). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the candle housing (39) of Anderson with filter mounting plate for connecting tubular or candle filter elements to the housing as suggested by Schmidt, Jr. et al (see col. 3, lines 70-75; col. 4, lines 67-73).

Regarding claims 11-12, Schmidt, Jr. et al teaches that the chamber (32) is in fluid communication with the tubular rack (32) and filter elements (64) (see Fig. 3).

Regarding claim 13, Schmidt, Jr. et al teach the filter element (64) comprising a permeable core (66) surrounded by compressed filter media (77) (see col. 5, lines 6-20).

Regarding claim 14, Schmidt, Jr. et al teach tubular filter element including a permeable core (66) that is threadably engaged to the mounting plate (37) via female coupling member (71) (see Fig. 3; col. 4, lines 67-73).

Regarding claim 15, Anderson teaches a header interconnected to the inlet pipe (see Fig. 1).

Regarding claim 16, Schmidt, Jr. et al teach a sloped floor pan (16) (see Fig. 1; col. 3, lines 44-52).

Regarding claim 17, Anderson teaches a plurality of compartments including a pair of tubular racks (45)(see Fig. 2) wherein each filter (31) defines separate compartment in the frame (11, 17).

11. Applicant's arguments with respect to claims 1-2 and 4-17 have been considered but are moot in view of the new ground(s) of rejection.

Regarding applicant's argument that there is no specific suggestion or teaching in the references to combine prior art, KSR forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board decision *Ex parte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007) (citing *KSR*, 82 USPQ2d at 1396).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Kim whose telephone number is 571-272-1142. The examiner can normally be reached on Monday-Friday 7 a.m. - 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/John Kim/  
Primary Examiner  
Art Unit 1797**

JK  
10/29/07